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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/582,423

09/22/2006

Alain-Dominique Jean-Pierre Gorse

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EXAMINER

BRUSCA, JOHN S

ART UNIT

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1631

MAIL DATE

DELIVERY MODE

06/02/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/582,423	Applicant(s) GORSE, ALAIN-DOMINIQUE JEAN-PIERRE	
	Examiner John S. Brusca	Art Unit 1631	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 and 45 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20-22, 25-32, 35, 36, 40 and 45 is/are rejected.
- 7) ☒ Claim(s) 23, 24, 32-34 and 37-39 is/are objected to.
- 8) ☒ Claim(s) 1-19 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>4/4/2007</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Status of the Claims

1. Claims 1-40 and 45 are pending.

Claims 20-22, 25-32, 35, 36, 40, and 45 are rejected.

Claims 23, 24, 32, 33, 34, and 37-39 are objected to

Claims 1-19 are allowable.

Election/Restrictions

2. Upon further consideration, the prior art cited to support the lack of unity in the Office action mailed 20 March 2009 does not make obvious the claimed subject matter and the restriction requirement is withdrawn. Neither Turkova nor Lyne show construction and use of a pharmacophore from an anchor site distinct from a binding site of a protein, or use of such a pharmacophore for identification of an anchor binding site ligand for the purpose of constructing a binding surface.

Because all claims previously withdrawn from consideration under 37 CFR 1.142 have been rejoined, **the restriction requirement as set forth in the Office action mailed on 20 March 2009 is hereby withdrawn.** In view of the withdrawal of the restriction requirement as to the rejoined inventions, applicant(s) are advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Once the restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable.

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See *In re Ziegler*, 443 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

Information Disclosure Statement

3. The information disclosure statement (IDS) submitted on 04 April 2007 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Objections

4. Claim 39 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 39 does not require a step that is not already recited in claim 1.

5. Claim 32 is objected to because of the following informalities: Claim 32 recites “a polymer backbone that is forms” which is unclear. Appropriate correction is required.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claim 45 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

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The subject matter of claim 45 is data. The pharmacophore model of claim 45 is not a process or product as defined in 35 U.S.C. 101. The claimed subject matter is nonfunctional descriptive material, and therefore is not statutory subject matter. See MPEP 2106.01.

Claim Rejections - 35 USC § 102

8. It is brought to the Applicant's attention that a product by process claim is examined for novelty and obviousness of the claimed product only, and that no consideration is given to the novelty or obviousness of the method of making the claimed product. See M.P.E.P. 2113.

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 20-22, 25-32, 35, 36, and 40 are rejected under 35 U.S.C. 102(b) as being anticipated by Turkova (Journal of Chromatography B, Vol. 722, pages 11-31 (1999)).

The claims are drawn to binding surfaces made by the process of claim 1. The product of the process of claim 1 includes proteins linked by carbohydrate moieties, or metal complexes to a substrate, or proteins linked by a biotin moiety to avidin or streptavidin.

Turkova reviews oriented proteins bound to a substrate. On pages 22-23 Turkova shows proteins bound by carbohydrate moieties to groups on a substrate, and further shows proteins bound by metal complexes to a substrate. On pages 24-26 Turkova shows proteins bound by a biotin moiety to avidin or streptavidin on a substrate.

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Allowable Subject Matter

11. Claims 23, 24, 33, 34, 37, and 38 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. An objection to claim 39 is detailed above.

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John S. Brusca whose telephone number is 571 272-0714. The examiner can normally be reached on M-F 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marjorie A. Moran can be reached on 571-272-0720. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John S. Brusca/

Primary Examiner, Art Unit 1631

jsb